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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,875	07/21/2003	Gerard von Hoffmann	PROGNX.006A	5901
20995	7590	01/26/2007	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			STIGELL, THEODORE J	
			ART UNIT	PAPER NUMBER
			3763	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	01/26/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/26/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/623,875	HOFFMANN, GERARD VON
	<b>Examiner</b>	<b>Art Unit</b>
	Theodore J. Stigell	3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 November 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 14-16, 18-20 and 37-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 14-16, 18-20, 37-43 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear if the "tubular body" and "tubular wall" are the same structure or not.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14, 18, 20, and 37-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Hillstead (5,066,285). Hillstead discloses an intracranial aspiration catheter comprising an elongate, flexible tubular body (12) having a proximal end, a distal end, and an aspiration lumen extending therethrough, a distally facing opening on the distal end of the aspiration lumen, a proximal section (14) on the body having a fixed diameter, a distal section (26) on the body in which the aspiration lumen including the distally facing opening is movable between a first, reduced inside diameter for transluminal navigation (Figure 4) and a second, enlarged inside diameter for aspirating

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material (Figure 5), an axially movable support (36) for controllably supporting the aspiration lumen against collapse when in the second diameter, and a control (proximal end of 36) for controlling the support, wherein the distal section is advanced from the first diameter to the second diameter in response to the distal movement of the support, wherein the support can be activated by rotating a first end of the support relative to a second end of the support, wherein the aspiration lumen is defined within a stretchable tubular wall, and wherein the body has a length from about 60 to 250 cm, wherein the proximal section has a length within the range of 20 to 220 cm, and wherein distal section has a length from about 2 to 50 cm.

Claims 14, 18, 20, and 37-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Ouchi (5,957,900). See Figures 14 and 15 and the respective portions of the specification. Ouchi discloses an intracranial aspiration catheter comprising an elongate, flexible tubular body (911) having a proximal end, a distal end, and an aspiration lumen extending therethrough, a distally facing opening (lumen of 914) on the distal end of the aspiration lumen, a proximal section on the body having a fixed diameter, a distal section (914) on the body in which the aspiration lumen including the distally facing opening is movable between a first, reduced inside diameter for transluminal navigation (Figure 15) and a second, enlarged inside diameter for aspirating material (Figure 14), an axially movable support (13) for controllably supporting the aspiration lumen against collapse when in the second diameter, and a control (22) for controlling the support, wherein the distal section is advanced from the first diameter to the second diameter in response to the distal movement of the support,

wherein the support can be activated by rotating a first end of the support relative to a second end of the support, wherein the aspiration lumen is defined within a stretchable tubular wall, and wherein the body has a length from about 60 to 250 cm, wherein the proximal section has a length within the range of 20 to 220 cm, and wherein distal section has a length from about 2 to 50 cm.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 15, 16, 19, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillstead (5,066,285) or Ouchi (5,957,900). Hillstead and Ouchi meet the claim limitations as described in claim 14 but fails to include a spiral coil and control wire, and a tubular wall having a plurality of folds therein when the aspiration is in the first diameter. At the time the invention was made, it would have been an obvious matter of design choice to include the limitations recited above on the devices of

Hillstead or Ouchi. Applicant has not disclosed that these limitations serve any advantage or particular purpose or solve any stated problem. The Applicant has not disclosed that the plurality of folds works any better than the wall made of stretchable material or that the control wire and spiral element work any better than an axially movable support. Either configuration allows the distal end of the catheter to expand equally well. Therefore, it would have been *prima facie* obvious to modify Hillstead and Ouchi with the folded walls and the spiral coil/control wire to obtain the invention as specified in claims 15-16, 19, and 43 because such modifications would have been considered a mere design consideration which fails to distinguish over the prior art.

***Response to Arguments***

Applicant's arguments with respect to claims 14-20 and 37-43 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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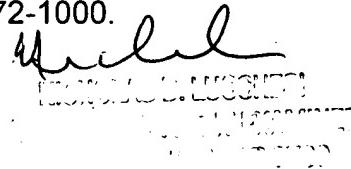
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore J. Stigell whose telephone number is 571-272-8759. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Theodore J. Stigell

  
THEODORE J. STIGELL  
EXAMINER  
ART UNIT 3763  
U.S. PATENT AND TRADEMARK OFFICE